

ESTTA Tracking number: **ESTTA774647**

Filing date: **10/04/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	Homeaway.com, Inc.		
Entity	Corporation	Citizenship	Delaware
Address	1011 W. Fifth Street Suite 300 Austin, TX 78703 UNITED STATES		

Attorney information	Georges Nahitchevansky Kilpatrick Townsend & Stockton LLP 1114 Avenue of the Americas New York, NY 10036 UNITED STATES ghn@kilpatricktownsend.com, kgarris@kilpatricktownsend.com, agarcia@kilpatricktownsend.com Phone:212-775-8700
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Registration Subject to Cancellation

Registration No	4840074	Registration date	10/27/2015
Registrant	Kaloko Rentals & Services LLC 73-1812 Hao Street Kailua Kona, HI 96740 UNITED STATES		

Goods/Services Subject to Cancellation


Class 036. First Use: 2014/12/28 First Use In Commerce: 2014/12/28
All goods and services in the class are cancelled, namely: Real estate services, namely, rental of vacation homes

Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act Sections 14(1) and 2(d)
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Mark Cited by Petitioner as Basis for Cancellation

U.S. Registration No.	2820989	Application Date	04/11/2003
Registration Date	03/09/2004	Foreign Priority Date	NONE
Word Mark	VRBO		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 036. First use: First Use: 1996/01/01 First Use In Commerce: 1996/01/01 Vacation real estate listing services; and providing such services via a global-computer network

Attachments	76505701#TMSN.png(bytes) Petition to Cancel Kaloko Kona Hawaii VRBO.pdf(274151 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Georges Nahitchevansky/
Name	Georges Nahitchevansky
Date	10/04/2016

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

HOMEAWAY.COM, INC.,)	
)	Cancellation No. _____
Petitioner,)	
)	Reg. No. 4,840,074
v.)	Mark:
)	KALOKA KONA HAWAII VRBO.COM
)	& Design
)	
KALOKO RENTALS & SERVICES)	
LLC,)	
)	
Respondent.)	
_____)	

PETITION FOR CANCELLATION

Petitioner Homeaway.com, Inc. (“Petitioner”), a Delaware corporation with a place of business at 1011 W. Fifth Street, Suite 300, Austin, Texas 78703, believes it will be damaged by the continued registration of the mark KALOKO KONA HAWAII VRBO.COM & Design illustrated in and covered by Registration No. 4,840,074, issued on October 27, 2015, to Kaloko Rentals & Services LLC (“Respondent”), and therefore states the following as its petition for cancellation of that registration:

1. Petitioner and its predecessor-in-interest (collectively, “Homeaway”) have operated, and continue to operate, an online marketplace for the vacation rental industry under the name and mark VRBO. Homeaway owns and operates a website at VRBO.COM that allows consumers using the VRBO services to rent vacation homes, apartments and RVs on a short-term basis.

2. Since at least as early as 1996, Homeaway has continuously used, and presently uses, the mark VRBO in interstate commerce throughout the United States (including Hawaii) in connection with the advertising and promotion of its short-term vacation rental services.

3. Petitioner owns a registration for the VRBO mark on the Principal Register of the United States Patent and Trademark Office (Registration No. 2,820,989), together with all right, title, and interest in the mark shown therein, and all of the business and goodwill represented thereby. A copy of the registration certificate and online printouts from the United States Patent and Trademark Office database for the VRBO registration are annexed hereto as Exhibit A. Petitioner's VRBO registration is valid and in full force and effect. In addition, Petitioner's VRBO registration has been deemed incontestable pursuant to Sections 8 and 15 of the Lanham Act.

4. As a result of Homeaway's long and continuous use of the VRBO mark and VRBO.COM website in connection with its services for short-term vacation rentals of homes, apartments and RVs, and as a consequence of Homeaway's advertising and promotion of such services under the VRBO mark, the consuming public and the trade have come to recognize, and do recognize, the VRBO mark as being used by Petitioner or by a single source, and associate and identify the vacation rental services offered under the VRBO mark with Petitioner or with a single source. Petitioner consequently derives an invaluable goodwill from this recognition, association, and identification by the consuming public and the trade.

5. Because of the inherent and acquired distinctiveness of the VRBO mark as a marketplace for the vacation rental industry, the length of time and extent to which Homeaway has used the VRBO mark and VRBO.COM website, the advertising and publicity for the VRBO mark, the national trading area in which the VRBO mark has been and is used, the degree of recognition amongst the relevant consumers of the VRBO services and VRBO.COM website as a marketplace for consumers to rent vacation homes, apartments and RVs on a short-term basis, and the registration of the VRBO mark with the USPTO, VRBO is recognized by the general

consuming public of the United States looking for vacation rentals as a designation of source of Petitioner's goods and services and deserving of a broad scope of legal protection.

6. Registration No. 4,840,074 for the KALOKO KONA HAWAII VRBO.COM & Design mark issued on October 27, 2015 ("Respondent's Mark"). The current owner of Registration No. 4,840,074 is Respondent Kaloko Rentals & Services LLC, a Hawaii limited liability Company with an address at 73-1812 Hao Street, Kailua Kona, Hawaii 96740.

7. Respondent's Mark shown in Registration No. 4,840,074 is registered in International Class 36 for "real estate services, namely, rental of vacation homes."

8. Homeaway began using the VRBO mark long before the first use, actual or constructive, of Respondent's Mark and long before registration of Respondent's Mark.

9. Respondent's Mark, and in particular the use of VRBO.COM in that mark, suggests a connection to Petitioner's previously used and registered VRBO mark, as the inclusion of VRBO.COM makes the mark similar in appearance, sound, connotation, and commercial impression to Petitioner's VRBO mark and VRBO.COM website.

10. Respondent's Mark is registered for services that are identical or highly related to those for which Homeaway has previously used the VRBO mark, for which Homeaway has registered the VRBO mark as shown in the VRBO registration, or which are in the natural zone of expansion for the VRBO mark.

11. Petitioner is damaged by the continued registration of Respondent's Mark because Respondent's Mark so resembles Petitioner's previously used VRBO mark as to be likely, when used on or in connection with the services of Respondent, to cause confusion, or to cause mistake, or to deceive. The continued registration of Respondent's Mark will continue to give

color of exclusive statutory rights to Respondent, in violation and derogation of the prior and superior rights of Petitioner.

WHEREFORE, Petitioner therefore requests that Registration No. 4,840,074 be cancelled, and that this Petition for Cancellation be sustained in favor of Petitioner.

The required \$300.00 fee is being submitted electronically with this Petition for Cancellation. The Director is authorized to debit Kilpatrick Townsend & Stockton LLP's Trademark Deposit Account No. 20-1430 for any deficiency in the required fee.

Please recognize Georges Nahitchevansky and Kristin Garris, and the law firm of Kilpatrick Townsend & Stockton LLP as attorneys for Petitioner in connection with this cancellation proceeding. Please address all correspondence regarding this proceeding to Georges Nahitchevansky at Kilpatrick Townsend & Stockton LLP, 1114 Avenue of the Americas, New York, New York 10036..

Dated: October 4, 2106

Respectfully submitted,

KILPATRICK TOWNSEND & STOCKTON LLP

By: /s/ Georges Nahitchevansky
Georges Nahitchevansky
1114 Avenue of the Americas
New York, New York 10036
Telephone: (212) 775-8720

Attorneys for Petitioner
Homeaway.com, Inc.

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

HOMEAWAY.COM, INC.,)	
)	Cancellation No. _____
Petitioner,)	
)	Reg. No. 4,840,074
v.)	Mark:
)	KALOKA KONA HAWAII VRBO.COM & Design
)	
KALOKO RENTALS &)	
SERVICES LLC,)	
)	
Respondent.)	
_____)	

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing Petition for Cancellation was served on Respondent at its address of record for Registration No. 4,840,074 on October __, 2016 via first class mail to:

Kaloko Rentals & Services LLC
73-1812 Hao Street
Kailua Kona, Hawaii 96740

/Georges Nahitchevansky/
Georges Nahitchevansky
Attorney for Petitioner

CERTIFICATE OF TRANSMITTAL

I hereby certify that a true copy of the foregoing Petition for Cancellation is being filed electronically with the TTAB via ESTTA on this day, October 4, 2016.

/Georges Nahitchevansky/
Georges Nahitchevansky
Attorney for Petitioner

EXHIBIT A

Int. Cl.: 36

Prior U.S. Cls.: 100, 101 and 102

United States Patent and Trademark Office

Reg. No. 2,820,989

Registered Mar. 9, 2004

**SERVICE MARK
PRINCIPAL REGISTER**

VRBO

VRBO.COM, LLC (COLORADO LTD LIAB CO)
4255 S. BUCKLEY ROAD, PMB #308
AURORA, CO 80015

FIRST USE 1-1-1996; IN COMMERCE 1-1-1996.

FOR: VACATION REAL ESTATE LISTING SERVICES; AND PROVIDING SUCH SERVICES VIA A GLOBAL COMPUTER NETWORK, IN CLASS 36 (U.S. CLS. 100, 101 AND 102).

SER. NO. 76-505,701, FILED 4-11-2003.

REBECCA GILBERT, EXAMINING ATTORNEY



United States Patent and Trademark Office

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[FIRST DOC](#) [PREV DOC](#) [NEXT DOC](#) [LAST DOC](#)[Logout](#) Please logout when you are done to release system resources allocated for you.[Start](#) List At: OR [Jump](#) to record: **Record 8 out of 8**[TSDR](#) [ASSIGN Status](#) [TTAB Status](#) (Use the "Back" button of the Internet Browser to return to TESS)**VRBO**

Word Mark	VRBO
Goods and Services	IC 036. US 100 101 102. G & S: Vacation real estate listing services; and providing such services via a global computer network. FIRST USE: 19960101. FIRST USE IN COMMERCE: 19960101
Mark Drawing Code	(1) TYPED DRAWING
Serial Number	76505701
Filing Date	April 11, 2003
Current Basis	1A
Original Filing Basis	1A
Published for Opposition	December 16, 2003
Registration Number	2820989
Registration Date	March 9, 2004
Owner	(REGISTRANT) VRBO.COM, LLC LIMITED LIABILITY COMPANY COLORADO 4255 S. Buckley Road, PMB #308 Aurora COLORADO 80015 (LAST LISTED OWNER) HOMEAWAY.COM, INC. CORPORATION DELAWARE 1011 W. FIFTH STREET SUIT 300 AUSTIN TEXAS 78703
Assignment Recorded	ASSIGNMENT RECORDED
Attorney of Record	Jason M. Vogel
Type of Mark	SERVICE MARK
Register	PRINCIPAL

Affidavit Text SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20130409.
Renewal 1ST RENEWAL 20130409
Live/Dead
Indicator LIVE

TESS HOME	NEW USER	STRUCTURED	FREE FORM	BROWSE Dict	SEARCH OG	TOP	HELP	PREV LIST	CURR LIST	NEXT LIST
FIRST DOC	PREV DOC	NEXT DOC	LAST DOC							

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From: TMOOfficialNotices@USPTO.GOV
Sent: Tuesday, April 9, 2013 11:02 PM
To: hrhee@kokkalaw.com
Subject: Trademark RN 2820989: Official Notice of Acceptance and Renewal under Sections 8 and 9 of the Trademark Act

Serial Number: 76505701
Registration Number: 2820989
Registration Date: Mar 9, 2004
Mark: VRBO
Owner: HOMEAWAY.COM, INC.

Apr 9, 2013

NOTICE OF ACCEPTANCE UNDER SECTION 8

The declaration of use or excusable nonuse filed for the above-identified registration meets the requirements of Section 8 of the Trademark Act, 15 U.S.C. §1058. **The Section 8 declaration is accepted.**

NOTICE OF REGISTRATION RENEWAL UNDER SECTION 9

The renewal application filed for the above-identified registration meets the requirements of Section 9 of the Trademark Act, 15 U.S.C. §1059. **The registration is renewed.**

The registration will remain in force for the class(es) listed below for the remainder of the ten-year period, calculated from the registration date, unless canceled by an order of the Commissioner for Trademarks or a Federal Court.

Class(es):
036

TRADEMARK SPECIALIST
POST-REGISTRATION DIVISION
571-272-9500

REQUIREMENTS FOR MAINTAINING REGISTRATION IN SUCCESSIVE TEN-YEAR PERIODS

WARNING: Your registration will be canceled if you do not file the documents below during the specified time periods.

What and When to File: You must file a declaration of use (or excusable nonuse) **and** an application for renewal between every 9th and 10th-year period, calculated from the registration date. See 15 U.S.C. §§1058, 1059.

Grace Period Filings

The above documents will be considered as timely if filed within six months after the deadlines listed above with the payment of an additional fee.

*****The USPTO WILL NOT SEND ANY FURTHER NOTICE OR REMINDER OF THESE REQUIREMENTS. THE REGISTRANT SHOULD CONTACT THE USPTO ONE YEAR BEFORE THE EXPIRATION OF THE TIME PERIODS SHOWN ABOVE TO DETERMINE APPROPRIATE REQUIREMENTS AND FEES.*****

To view this notice and other documents for this application on-line, go to <http://tdr.uspto.gov/search.action?sn=76505701>. NOTE: This notice will only be available on-line the next business day after receipt of this e-mail.